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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,902	01/16/2002	Shunpei Yamazaki	740756-2405	2970
31780 ERIC ROBINSON PMB 955 21010 SOUTHBANK ST. POTOMAC FALLS, VA 20165	7590 04/10/2007		EXAMINER POTTER, ROY KARL	
			ART UNIT 2822	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/10/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/045,902

Applicant(s)

YAMAZAKI, SHUNPEI

Examiner

Roy K. Potter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on - the interview of 4/5/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Reissue Applications***

Claims 1-35 are rejected as being based upon a defective reissue basis under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the basis is set forth in below.

35 U.S.C. 251 Reissue of defective patents recited the following:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

Here there is no unexpired part of the term of the original patent. This application seeks to correct alleged errors in U.S. Patent No. 6,180,991. This patent is subject to a Terminal Disclaimer. The Terminal Disclaimer disclaims any portion of the patent term that would extend beyond the term of U.S. Patent No. 4,581,476, which issued on April 8, 1986. The term of U.S. Patent No. 4,581,476 ended on April 8, 2003, and therefore

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the 6,180,991 patents expired on the same date. There is no longer any unexpired part of the term of the original patent during which correction by reissue would be feasible.

Claims 1 - 35 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

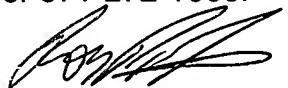
The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

The reissue oath/declaration filed with this application is defective because none of the errors, which are relied upon to support the reissue application, are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The alleged errors here do not recite an error in the specification, drawings, or claims, which causes the original patent to be defective. The errors include the error of the applicant in failing to ensure proper disposition of the Petition to Withdraw a Terminal Disclaimer during the prosecution of the '235 application; the error of the applicant in not withdrawing the '235 application from issuance under 37 CFR 1.313 before payment of the issue fee; the error of the applicant in not withdrawing the '235 application from issuance under 37 CFR 1.313 after payment of the issue fee; the error of the applicant in not deferring issuance of the patent under 37 CFR 1.314 until the outstanding Petition to Withdraw a Terminal Disclaimer was considered and the error of the PTO in failing to consider and act upon the Petition to Withdraw a Terminal Disclaimer filed 21 months prior to issuance of the subject '991 patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy K. Potter whose telephone number is 308 - 4106. The examiner can normally be reached on M-F.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roy K Potter  
Primary Examiner  
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